

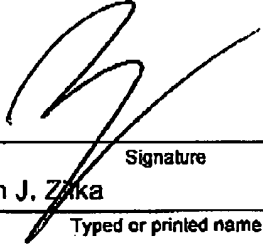
NOV 16 2006

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-06)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) NA11P462/01.059.01	
I hereby certify that this correspondence is being transmitted via facsimile to the Commissioner for Patents, Alexandria, VA 22313-1450 to fax number (571) 273-8300. on <u>November 16, 2006</u> Signature <u><i>April Skovmand</i></u> Typed or printed name <u>April Skovmand</u>		Application Number <u>09/912,391</u>	Filed <u>07/26/2001</u>
		First Named Inventor <u>Neil John Hursey</u>	
		Art Unit <u>2131</u>	Examiner <u>Henning, Matthew T.</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/>	applicant/inventor.	Signature	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)	Kevin J. Zilka Typed or printed name	
<input checked="" type="checkbox"/>	attorney or agent of record. <u>41,429</u> Registration number	<u>408-971-2573</u> Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>11/16/06</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/>	*Total of <u>1</u> forms are submitted.		

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

The Examiner has objected to the specification, and rejected Claims 1-4, 6-12, 14-20, and 22-28 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner has argued that "there is support for each of (i), (ii) and (iii) in the alternative, as shown in page 7 line 30 – page 8 line 15 of the present specification, but never as a combination." Applicant respectfully disagrees and points out that page 6, lines 12-13 of the specification states that "the anti-virus mechanism 6 can apply the techniques described hereinafter to resist mass mailing malware," and also notes that page 9, lines 21-22 of the specification states that "the general purpose computer 200 operating under control of a suitable computer program may perform the above described techniques" (emphasis added). Thus, support for the combination of (i), (ii), and (iii) claimed in each of the independent claims is present.

Additionally, the Examiner has rejected Claims 1-3, 7, 9-11, 15, 17-19, and 23 under 35 U.S.C. 103(a) as being unpatentable over Bates et al. (U.S. Patent No. 6,779,021) in view of Marsh (U.S. Patent No. 6,763,462). Applicant respectfully disagrees with such rejection.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

With respect to the first element of the *prima facie* case of obviousness and, in particular, the obviousness of combining the aforementioned references, the Examiner

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has argued that it would have been obvious to combine Bates with Marsh because “the ordinary person skilled in the art would have been motivated to provide means of detecting viral spam as suggested by Marsh, as well as giving the user the final say in what is to be done with detected viral spam...[and that] in this combination it would be obvious that the messages would be held in a ‘quarantine’ for a predetermined amount of time prior to sending in order for the user to have the option of deleting the messages detected as being viral spam without sending the messages.” To the contrary, applicant respectfully asserts that it would not have been obvious to combine the teachings of the Bates and Marsh references, especially in view of the vast evidence to the contrary.

For example, the Bates reference teaches that “[i]n accordance with the present invention, multiple e-mails are received at a network server intended for multiple clients served by the network server” (see Abstract) and that “[b]lock 92 depicts a determination as to whether or not the number of recipients of the new e-mail is greater than a designated ‘A’ number of recipients...[where] a rule designating the ‘A’ number of recipients is preferably included in spam filtering rules for the server” (see Bates Col. 8, lines 56-60). On the other hand, the Marsh reference teaches that “the virus detection utility 104 may be an add in program organized into a conventional format such as a plug-in for the e-mail application 102” where “[f]or example, the virus detection utility 104 [is] stored as a dynamic link library (DLL) file and...include[s] routines to execute in conjunction with the e-mail application 102 to perform specific operations” (see Marsh Col. 2, lines 26-33).

Clearly, in Marsh, the virus detection utility runs on clients in conjunction with email applications located on such clients, and utilizes client-based information (e.g. address books), whereas, in Bates, a server is used to receive emails sent to clients and to predict undesirable emails utilizing rules stored on the server. Thus, Marsh clearly *teaches away* from Bates. Applicant respectfully points out that it is improper to combine references where the references *teach away* from their combination. *In re Grasselli*, 713 F.2d 732, 743, 218 USPQ 769, 779 (Fed. Circ. 1983). To this end, Marsh and Bates represent an *unworkable* combination since the client-based information,

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namely address books of clients, as in Marsh, would not be available to the server in Bates for predicting undesirable emails.

More importantly, with respect to the third element of the *prima facie* case of obviousness, and particularly with respect to the independent claims, the Examiner has relied on Col. 9, lines 3-19 from the Bates reference to make a prior art showing of applicant's claimed "comparison logic operable to compare said e-mail message with at least one of an address book of a sender of said e-mail message and one or more previously generated e-mail messages from said client computer" (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully notes that the excerpt from Bates relied on by the Examiner simply teaches "comparing the new e-mail source address with the source addresses of e-mail received during a designated 'B' time period" (emphasis added). Clearly, in Bates, a new e-mail source address is only compared with e-mail received, which does not meet "compare[ing] said e-mail message with at least one of an address book of a sender of said e-mail message and one or more previously generated e-mail messages from said client computer" where "said previously generated e-mail messages [are held] in a quarantine queue for at least a predetermined quarantine period prior to being sent from said client computer," as specifically claimed by applicant (emphasis added).

Additionally, with respect to the independent claims, the Examiner has relied on Col. 9, line 64 – Col. 10, line 10 from the Bates reference to make a prior art showing of applicant's claimed "identifying logic operable to identify whether...said e-mail message contains message content having at least a threshold level of similarity to non-identical message content of said previously generated e-mail messages being sent to more than a threshold number of addressees specified within said address book" (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts the excerpt from Bates relied on by the Examiner merely discloses "comparing the content of e-mails that are the same size as the new e-mail with the content of the new e-mail" (emphasis added). However, applicant claims a

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technique where “said e-mail message contains message content having at least a threshold level of similarity to non-identical message content of said previously generated e-mail messages being sent to more than a threshold number of addressees specified within said address book” (emphasis added), in the context claimed. Applicant notes that simply nowhere in Bates is there any disclosure of “e-mail messages being sent to more than a threshold number of addressees specified within said address book,” in the context claimed by applicant (emphasis added).

Additionally, applicant respectfully points out block 98 in Fig. 4A of the Bates reference, which “depicts a determination as to whether or not the number of users receiving e-mail from the same source address during the ‘B’ time period is greater than a designated ‘C’ number of recipients” (Col. 9, lines 9-12). In Fig. 4A, if the determination in block 98 results in an affirmative, or “YES,” result, the process skips block 114, which “depicts a determination as to whether or not substantial similarities in content are found between the new e-mail and a particular amount of same sized e-mail” (Col. 10, lines 1-4), and instead proceeds directly to block 120, which “illustrates marking the new e-mail as predicted spam” (Col. 10, lines 17-18). Clearly, this fails to meet, and even *teaches away* from applicant’s claimed “identifying logic operable to identify whether...said e-mail message contains message content having at least a threshold level of similarity to non-identical message content of said previously generated e-mail messages being sent to more than a threshold number of addressees specified within said address book,” as claimed (emphasis added).

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to Claim 25, as rejected under 35 U.S.C. 103(a) as being unpatentable over Bates, in view of Marsh, in further in view of Radatti et al. (U.S. Patent No. 6,763,467), the Examiner has relied on Col. 1, lines 36-48 of the Radatti reference, to make a prior art showing of applicant’s claimed technique “wherein said e-mail message is identified as potentially containing malware only if said e-mail message includes an executable element, to speed processing.” Specifically, the

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Examiner has argued that "Radatti teaches that only executable code may contain malware."

Applicant respectfully points out that the excerpt from Radatti merely discloses that "[a]ll binary executables, unreviewed shell scripts, and source code accessed from an external network may contain worms, viruses, or trojan horses" and that "outside binary executables, shell scripts, and scanned source code may enter an internal network or single computer system through an E-mail attachment" (emphasis added). However, simply disclosing that executables may contain worms, viruses, or Trojan horses, as in Radatti, does not specifically teach any sort of e-mail, let alone meet applicant's specifically claimed technique "wherein said e-mail message is identified as potentially containing malware only if said e-mail message includes an executable element, to speed processing," as claimed by applicant (emphasis added).

In addition, with respect to Claim 26, the Examiner has relied on Col. 1, line 66-Col. 2, lines 7 in Bates to make a prior art showing of applicant's claimed technique "wherein said e-mail message is identified as potentially containing malware when said e-mail message and said previously generated e-mail messages share a common attachment." Applicant respectfully asserts that such excerpt from Bates only discloses that "other destructive attachments...can easily be transmitted within a server upon activation of a single client within a network." Clearly, only mentioning an attachment, as in Bates, does not even suggest applicant's specific claim language, namely that "said e-mail message is identified as potentially containing malware when said e-mail message and said previously generated e-mail messages share a common attachment," as claimed (emphasis added).

Thus, at least the first and third elements of the *prima facie* case of obviousness have not been met, since the combination of the prior art references is improper, and since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.